



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,945	07/22/2003	Edward T.H. Yeh	UTSH:245USC1	2419

7590 06/12/2006

Gina N. Shishima
Fulbright & Jaworski L.L.P.
Suite 2400
600 Congress Ave.
Austin, TX 78701

EXAMINER

MOORE, WILLIAM W

ART UNIT	PAPER NUMBER
----------	--------------

1656

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,945

Applicant(s)

YEH ET AL.

Examiner

William W. Moore

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006 and 19 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 45-65 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1656

DETAILED ACTION

Priority

Applicant's claim in the Declaration of Inventorship and page 2 of the specification filed 22 July 2003 to priority under 35 U.S.C. § 119 of the 31 July 1999 filing date of the US provisional application serial No. 60/146,744, and the 31 July 2000 filing date of its successor US utility application serial No. 09/628,966, of which the instant application is a continuation, is hereby acknowledged.

Information Disclosure Statement

Applicant's Information Disclosure Statement [IDS] filed on 15 September 2003 is hereby acknowledged. Executed copies of the three pages of Form PTO-1449 citing foreign patent publications and journal publications will be provided for Applicant in the first communication on the merits in this application.

Preliminary Amendment

Applicant's Preliminary Amendment filed with the application on 22 July 2003 has been entered, canceling claims 1-44 and adding the new claims 46-65 and revising the continuing data at page 2 of the specification by incorporating details of US application 09/628,966, and its current status, is also acknowledged.

Restriction

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 45-50 and 54 drawn in part to, and claims 52 and 55-63 drawn particularly to, a polypeptide comprising part or all of the SENP1 protease with the amino acid sequence of SEQ ID NO:2, classified in class 435, subclass 226.
- II. Claims 45-50 and 54 drawn in part to, and claim 51 drawn particularly to, a polypeptide comprising part or all of the SENP2 protease with the amino acid sequence of SEQ ID NO:8, classified in class 435, subclass 226.
- III. Claims 45-50 and 54 drawn in part to, and claim 53 drawn particularly to, a polypeptide comprising part or all of the SENP3 protease with the amino acid sequence of SEQ ID NO:10, classified in class 435, subclass 226.

Art Unit: 1656

- IV. Claims 64 and 65, drawn to a method of use of an antibody specific to a SENP1 polypeptide to purify a SENP1 polypeptide present in a sample, classified in class 530, subclass 413.

The inventions are distinct, each from the other, because of the following reasons:

Inventions of Groups I, II, and III are unrelated, one to another. Each protease is an independent chemical entity having a structure distinct from those of the other proteases, requiring separate searches in commercial and USPTO amino acid sequence databases and in the publications of the prior art. Restriction is proper where each polypeptide differs in structure from the other polypeptides such that each search is a separate burden on the resources of the USPTO when distinct polypeptides are disclosed that are not substantially related, one to the other.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

The inventions of Groups I-III are unrelated to the invention of Group IV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case Groups I-III require protease products with characteristic structures and Group IV is drawn to a method requiring antibodies where the products required by Group I are neither structurally nor functionally related to the products required for the method of Group II and the products of Group I-III are not disclosed as capable of use together with, and have different designs, modes of operation, and effects than, products used in a method of Group IV.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Election

A telephone call was made to Ms. Gina N. Shishima on 7 June 2006 to request an oral election to the above restriction requirement, but did not result in an election being

Art Unit: 1656

- IV. Claims 64 and 65, drawn to a method of use of an antibody specific to a SENP1 polypeptide to purify a SENP1 polypeptide present in a sample, classified in class 530, subclass 413.

The inventions are distinct, each from the other, because of the following reasons:

Inventions of Groups I, II, and III are unrelated, one to another. Each protease has a primary structure that is distinct from the structures of the other proteases, requiring separate searches in commercial and USPTO amino acid sequence databases and in the publications of the prior art. Restriction is proper where each polypeptide differs in structure from another polypeptide such that each search is a separate burden on the resources of the USPTO where the distinct polypeptides are not disclosed to be significantly related, one to the other.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

The inventions of Groups I-III are unrelated to the invention of Group IV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case Groups I-III require protease products with characteristic structures and Group IV is drawn to a method requiring antibodies where the products required by Group I are neither structurally nor functionally related to the products required for the method of Group II and the products of Group I-III are not disclosed as capable of use together with, and have different designs, modes of operation, and effects than, products used in a method of Group IV.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Election

A telephone call was made to Ms. Gina N. Shishima on 7 June 2006 to request an oral election to the above restriction requirement, but did not result in an election being

Art Unit: 1656

made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee withdrawn required under 37 CFR 1.17(i).

Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William W. Moore whose telephone number is 571.272.0933 and whose FAX number is 571.273.0933. The examiner can normally be reached Monday through Friday between 9:00AM and 5:30PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisory Primary Examiner, Dr. Kathleen Kerr, can be reached at 571.272.0931. The official FAX number for all communications for the organization where this application or proceeding is assigned is 571.273.8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571.272.1600.

William W. Moore
7 June 2006


NASHAAT T. NASHED PHD.
PRIMARY EXAMINER